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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,544	10/13/2000	Sarkis Barret Kalindjian	40283/183	8561

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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/16/2001

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/622,544

Applicant(s)
Kalindjian et al.

Examiner
Bruck Kifle

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 26, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-27 is/are pending in the application.
- 4a) Of the above, claim(s) 2-10 and 12-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 20) ☐ Other: _____

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Election/Restriction

Applicant's election with traverse of the compound of example 71 (claims 1, 4, 6-13, 20, 24, 25 and 28) in Paper No. 8 is acknowledged. The traversal is on the grounds that the significant structural element is the saturated heterocycle ring substituted with C2 to C10 alkylene. This is not found persuasive because there is no single ring that is present that is shared by all of the alternatives which is inventive. There is no common structural feature shared by all of the alternatives of the formula of claim 1.

The claims are drawn to structurally dissimilar compounds which are classified separately, require separate literature searches and are not art recognized equivalents. They are made and used independently.

Note that compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept under PCT Rule 13.1, 37 CFR 1.475(d). The compounds of the formula in claim 1 are not so linked as to form a single inventive concept. The compounds are so diverse in scope that a prior art anticipating one compound under 35 USC 102 would not render obvious another compound of the same claim under 35 USC 103.

The requirement is still deemed proper and is therefore made FINAL.

The elected compound was not found in the prior art and the search was expanded.

Claims 2-27 are withdrawn from consideration because art was found (see MPEP 803.02.)

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Applicants are also advised of MPEP 803.02 Restriction - Markush Claims [R - 2], fourth paragraph, where is stated;

“As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**” (emphasis added).

Improper Markush Rejection

Claim 1 is rejected under a judicially created doctrine as being drawn to an improper Markush group, that is, the claims lack unity of invention. The structural formula in claim 1 is defined in such a way that it keeps changing the core of the compound that determines the classification. By changing the values of the variables, several patentably distinct and independent compounds are claimed. In order to have unity of invention the compounds must have “a community of chemical or physical characteristics” which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification” In re JONES (CCPA) 74 USPQ 149 (see footnote 2). This structural formula does not have a

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significant structural feature that is shared by all of its alternatives which is inventive. Even the elected pyrrolidinyl group along with the definitions of the variables is not inventive (see Gerard et al. (FR 2694003), compounds with RN 155019-18-4, 155019-19-5 and 77709-56-9).

Compounds embraced by claim 1 are so diverse in nature that a prior art anticipating a claim with respect to one member under 35 USC 102 would not render obvious the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

Limiting the claims to the elected group would overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gerard et al. (FR 2694003). The claim reads on compounds of RN 155019-18-4, 155019-19-5 and 77709-56-9. (see attached CAS abstract and structures). These compounds correspond to instant claim when, in the instant claim, x is 2, R¹ is methyl, Y is ethylene, Z is N-S(O)₂, R⁵ is methyl and R² is naphthyl.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al. (WO 93/04042). The claim reads on compounds of RN 151642-44-3P and 151642-45-4P (see CAS abstract and structures. The reference is 218 pages long and has not been provided).

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Schohe et al. (US 5,274,097). The claim reads on compounds of RN 127341-41-7P; 127341-57-5P and 127366-99-8P (see CAS abstract and structures. The reference is 50 pages long and has not been provided).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Boudet-Dalbin et al. (Eur. J. Med. Chem.--Chim. Ther. (1986), 21(2), 131-7). The claim reads on the compound of RN 103595-49-9P. (see CAS abstract and structures).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jozic (US 4,396,622). The claim reads on compounds on columns 11-26 (see also CAS abstract and structures attached).

Copious amount of art was found during the search so that a full prior art examination could be made at this time.

Claim Rejections - 35 USC § 112

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The definition of R¹ as "C₁ to C₁₀ hydrocarbyl, in which up to 2 carbon atoms may be replaced by O, S or N, and up to 2 hydrogen atoms may be replaced by halogen" is indefinite. One cannot say for sure what is included and what is not within the scope of this group. The term is self contradictory because a hydrocarbyl cannot have a heteroatom present. It is unclear where a heteroatom is permitted. See also definitions of R²-R⁷ for the same problem. This group is

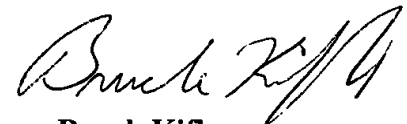
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confusing. Applicants are advised to insert the limitations similar to those in the dependent claims to clarify these groups.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

November 14, 2001



Bruck Kifle
Primary Examiner
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